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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/164.216 09/30/98 PASQUALINI

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EXAMINER

NADAV, O

ART UNIT

PAPER NUMBER

2811

DATE MAILED:

06/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.
09/164,216

Applicant(s)
Pasqualini

Examiner
ORI NADAV

Art Unit
2811

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 15, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 5, 6, 10, 11, 15, 17-23, and 33-37 is/are pending in the application.
- 4a) Of the above, claim(s) 1, 5, 6, 10, 11, 17, 18, 20-23, and 33-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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DETAILED ACTION

Election/Restriction

1. Applicant's election with traverse of the embodiment of figure 16 in Paper No. 21 is acknowledged. The traversal is on the ground(s) that the search and examination of the cited claims do not impose serious burden on the examiner, because the examiner already performed a search and examined all of the cited claims. This is not found persuasive because the examiner did not perform search and examination of the newly cited claims. The inventions recited in claims 1, 5, 6, 10, 11, 15, 17-21 and 33 are distinct, each from the other, and require search in separate classes, such as class 257, class 327, class 361 and class 716. Although the examiner performed a search and examined the claims cited in papers 9 and 11, the newly cited claims impose serious burden on the examiner because the examination requires new search in four separate classes. MPEP § 808 clearly states that a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search. In this case, the newly cited claims are in different field of search AND require a search in separate classification.

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Applicant further elects, in page 2, the embodiment of figures 10-11 of the claimed subcombination. This election is moot in view of the earlier election of the embodiment of figure 16 (the combination).

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1, 5, 6, 10, 11, 17, 18, 20, 21 and 33 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected subcombination, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 21.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 15 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gens et al. (5,515,225) in view of Admitted Prior Art (APA).

Gens et al. teach in figure 2 a semiconductor chip having a substrate (figure 4, the external line encircling R1) of a first conductivity type, the chip comprising: a plurality of

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pads P1, P2, an ESD negative ring R2, a plurality of ESD positive lines (the lines between the high power supply terminals and line R1. See column 3, lines 32-49) not being connected to a steady voltage source, a plurality of switches (diodes) connected between the ESD positive lines and the ESD negative ring, and a plurality of first and second diodes D1, D2 connected to a pad and the negative ring and positive line, respectively.

Although Gens et al. do not explicitly state that plurality of switches are connected between the ESD positive lines and the ESD negative ring, this feature is inherent in Gens et al.'s device, because it is well known in the art that diodes are switches, of which official notice may be taken. Therefore, Gens et al. teach plurality of switches being connected between the ESD positive lines and the ESD negative ring, as claimed. Thus, Gens et al.'s structure is considered to be at least obvious over the claimed structure.

In the alternative, APA teaches in figure 1 a plurality of ESD switches connected to the positive line and to the negative ring, respectively (page 2, lines 24-27).

It would also have been obvious to a person of ordinary skill in the art at the time the invention was made to connect plurality of ESD switches between the positive line and the negative ring in Gens et al.'s device in order to provide more effective unidirectional flow of current during ESD operation.

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Regarding claim 19, Gens et al. teach in figure 4 a negative line encircling the periphery of the chip.

Response to Arguments

5. Applicant argues on page 11 that Gens et al. do not teach a plurality of ESD positive lines. Applicant correlates bus R1 of Gens et al. to the claimed limitations of plurality of ESD positive lines, and requires Gens et al. to show plurality of buses R1. Applicant then argues that since Gens et al. do not teach plurality of buses R1, then Gens et al. do not teach the claimed invention.

Bus R1 of Gens et al. should not be correlated to a plurality of ESD positive lines. Gens et al. teach plurality of power supply terminals connected via diodes to bus R1. The lines connecting the power supply terminals to bus R1 are the claimed plurality of ESD positive lines. Therefore, Gens et al. teach a plurality of ESD positive lines, as claimed.

6. The rest of applicant's arguments with respect to claims 15 and 19 have been considered but are moot in view of the new ground(s) of rejection.

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Papers related to this application may be submitted to Technology center (TC) 2800 by facsimile transmission. Papers should be faxed to TC 2800 via the TC 2800 Fax center located in Crystal Plaza 4, room 4-C23. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Group 2811 Fax Center number is (703) 308-7722 and 308-7724. The Group 2811 Fax Center is to be used only for papers related to Group 2811 applications.

Any inquiry concerning this communication or any earlier communication from the Examiner should be directed to *Examiner Nadav* whose telephone number is (703) 308-8138. The Examiner is in the Office generally between the hours of 7 AM to 3 PM (Eastern Standard Time) Monday through Friday.

Any inquiry of a general nature or relating to the status of this application should be directed to the **Technology Center Receptionists** whose telephone number is 308-0956


TOM THOMAS
SUPERVISORY PATENT EXAMINER

Ori Nadav, Ph.D.

May 28, 2001